



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,323	01/31/2002	Carl W. Gilbert	329.1001-U	9839

20311 7590 04/14/2005

MUSERLIAN, LUCAS AND MERCANTI, LLP  
475 PARK AVENUE SOUTH  
15TH FLOOR  
NEW YORK, NY 10016

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/066,323

Applicant(s)

GILBERT ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14, 16, 22, 24, 25 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 16, 22, 24, 25 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Final Rejection**

#### **The Status of Claims:**

Claims 1-12, 14, 16, 22, 24-25, and 31 are pending.

Claims 1-12, 14, 16, 22, 24-25, and 31 have been rejected.

#### **Claim Objections**

In claims 5 and 24, the phrase "an N-hydroxysuccinimidyl group " is recited. The article "an" is improper. Therefore, an appropriate correction is required.

#### **Claim Rejections - 35 USC § 112**

1. Applicants' argument filed 12/16/04 have been fully considered but are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-12, 14, 16, 22, 24-25, and 31 under 35 U.S.C. 112, second paragraph has been maintained due to applicants' failure to modify the claims in the amendment.

In claim 1 , the phrase " A compound comprising " is recited. The expression is vague and indefinite because the word " comprising " would mean that there other

additional components besides the compound. Therefore, an appropriate correction is required.

In claim 1 , the phrase "L is a linker " is recited. The expression is vague and indefinite because the term " a linker " is not defined in the compound claim. Therefore, an appropriate correction is required.

In claims 1 and 31, the phrase "electron donating or electron withdrawing groups " is recited. The expression is vague and indefinite because the specification does not define what is meant by the phrase "electron donating or electron withdrawing groups". Therefore, an appropriate correction is required.

In the amended claims 5-6 and 24 , the phrases " L-B includes " and " R<sub>11</sub> includes " are recited. The expressions are still vague and indefinite because the word " includes " is similar to the word "comprising" , which would mean that there other additional components. The examiner recommends to change from " includes " to " is ". Therefore, an appropriate correction is required.

In claim 9 , the phrase "R<sub>11</sub> comprises " is recited. The expression is vague and indefinite because the word " comprises " would mean that there other additional components besides the R<sub>11</sub> compound. The examiner recommends to change from " comprises " to " is ". Therefore, an appropriate correction is required.

In claim 31, the phrase

“

wherein:  $R_{15}$  and  $R_{16}$  are individually selected from the group consisting of H,  $CH_3$ ,  $C_2-C_{10}$  alkyls,  $C_2-C_{10}$  alkenyls or  $C_2-C_{10}$  alkynyls, each of which can be substituted or unsubstituted; straight or branched; and  $C_2-C_{10}$  heteroalkyls,  $C_2-C_{10}$  heteroalkenyls or  $C_2-C_{10}$  heteroalkynyls;

” is recited. The expression is vague and indefinite because the last group is recited as “ or

$C_2-C_{10}$  heteroalkynyls”. This is still open in the Markush group expression. The examiner recommends to change from “or  $C_2-C_{10}$  heteroalkynyls” to “ and  $C_2-C_{10}$  heteroalkynyls”. Therefore, an appropriate correction is required.

In claim 31, the phrase “  $L_1$  is a moiety containing a functional group capable of reacting with the  $NHR_{22}$ ” is recited. The expression is vague and indefinite because  $L_1$  is clearly not defined in the compound formula;  $L_1$  needs to have a structural chemical formula in the compound claim. Therefore, an appropriate correction is required.

In claim 31, the term “the  $NHR_{22}$ ” is recited. The expression is vague and indefinite because the variable “ $R_{22}$ ” is clearly not defined in the compound formula. Therefore, an appropriate correction is required.

In claim 31, the phrase "polymeric supports" is recited. The expression is vague and indefinite because the specification does not elaborate on what is meant by the phrase "polymeric supports". Therefore, an appropriate correction is required.

#### Applicants' Argument

Applicants argue the following issues:

- a. The Examiner has not made a proper prima facie case of indefiniteness; applicants have defined certain portions of the claimed compound as a "first and a "second " moiety in order to distinguish them ; furthermore, the specification has described the A and B moieties ; therefore, they are definite ;
- b. The commonly-assigned US 6,774,116 has the same and similar descriptions used for the terms A, B, polymer, active moiety;
- c. The terms "electron donating or withdrawing groups" are well-known to those of ordinary skill; therefore, applicants are not required to give an exhaustive list of such groups;
- d. It is not necessary to describe what does not react with  $\text{NHR}_{22}$  since the claims do not embrace the inoperative.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first argument, the Examiner has noted applicants' arguments. However, the terms such as the "first " and the "second " moiety are used in the compound claims without specifying each of the chemical moieties; this is indefinite because there is no way of telling which one is the first or the second moiety; in order to identify the clear boundaries of the compounds, each substituent attached to the core of the compounds needs to be specific. Otherwise, the current inventors may claim the future the "first " and the "second " moiety ,which have not been discovered yet. Because of this, it is also a Reach -Through Claim. Therefore, in order to overcome the rejection, the examiner recommends to add each of the specific "first " and the "second " chemical moieties to the claims.

Second, regarding the second argument, the Examiner has noted applicants' arguments. However, the commonly-assigned US 6,774,116 is examined by another examiner, which I can not make any remark on. But I can say that the examiner did it before the policy of Tech center has been changed. Therefore, the issues of the claims are still remained.

Third, regarding the third argument, the Examiner has noted applicants' arguments. However, the expression of "electron donating or electron withdrawing groups "is still vague and indefinite because the specification does not define what is meant by the phrase "electron donating or electron withdrawing groups". Therefore, the rejection is to be maintained.

Fourth, regarding the fourth argument, the Examiner has noted applicants' arguments. However, regardless of the  $L_1$  having a functional group capable of reacting with the  $NHR_{22}$ ,  $L_1$  needs to have a structural chemical formula in the compound claim; otherwise, the limitation of  $L_1$  becomes indefinite in the compound formula. Therefore, the rejection is proper.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 1625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\* *myr jh*  
*4/11/05*

*Cecilia J. Tsang*  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600